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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,709	08/31/2000	Oscar Lee Avant	08049.009	3489
22852	7590	10/08/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			RODRIGUEZ, JOSEPH C	
		ART UNIT	PAPER NUMBER	
		3653		

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/652,709	AVANT ET AL.
	Examiner	Art Unit
	Joseph C Rodriguez	3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) 9-76,83-90 and 97-158 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8,77-82 and 91-96 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 August 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 8/26/04.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Final Rejection

Applicant's arguments filed 7/06/04 have been fully considered but they are not persuasive for reasons detailed below.

The 35 U.S.C. 112 rejections are maintained or modified as follows:

The previous rejections have been withdrawn. Here, it is noted that the "determining if"-step language in the method claim has been interpreted by Examiner as requiring the prior art to determine if the mail piece has a code on the front *and* if the mail piece has a code on the back. Further, it is also noted that the processing step, wherein mailpieces are processed if no code is found on either surface, is a *conditional* step. That is, if a code is found on either surface and the mail is sorted based on said code, the conditional step is not unnecessary, as the claim has already been anticipated. Consequently, the conditional step need not be present in the prior art to anticipate the claimed invention if the prior sorting conditions have been properly fulfilled.

Further, the claims still stand rejected as follows:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 77-82, 91-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding these claims, the language "may be"(claim 1, 2nd ln. from bottom; claim 77, 2nd ln. from bottom; claim 77, 2nd ln. from bottom) renders the claims indefinite as it is unclear whether the features subsequent to the "may be" language are a necessary part of the claimed invention. Applicant must positively recite the features of the claimed invention. Examiner thus recommends eliminating all instances of "may be" from the claim language.

The prior art rejections are maintained or modified as follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 77-82 and 91-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Okabe (US 5,025,475).

Okabe teaches a method (Fig. 1-5) comprising determining if the mailpiece includes a code on the front of the mailpiece *and* if the mailpiece includes a code on the back of the mailpiece, the mailpiece also having a textual destination address on the front of the mailpiece (Abstract, col. 3, ln. 3-40; col. 6, ln.64); and sorting the mailpiece using a code on the front of the mailpiece, if it was determined that the mailpiece includes a code on the front of the mailpiece, identifying the mailpiece using a code on the back of the mailpiece, if it was determined that the mailpiece includes a code on the

back of the mailpiece only (col. 6, ln.–col. 7, ln. 27). Here, as explained above, it is again worth noting that there is no need to anticipate the final step of applying an ID code to a mailpiece with no code on either surface, as stated in base claims 1, 77 and 91, as this step is conditional (i.e., the claim has already been fulfilled and thus anticipated). Further, the various identification markings claimed in claims 5-8, 81-82 and 95-96 were also rendered anticipated and thus moot as these features were conditional and not necessary to anticipate the claimed method.

This application contains claims 9-76, 83-90 and 97-158 drawn to an invention nonelected without traverse in the paper of November 10, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is 703-308-8342. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is 703-872-9326 (After-Final 703-972-9327).

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is 703-306-2571 or 703-308-6552.

The examiner's **UNOFFICIAL Personal fax number** is 703-746-3678.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **703-308-1113**.

October 4, 2004


DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600